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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,282	01/26/2004	Hubert Heeg	87333.3301	6488
7590	04/25/2006		EXAMINER	
BAKER & HOSTETLER LLP			SOOHO, TONY GLEN	
Washington Square, Suite 1100			ART UNIT	PAPER NUMBER
1050 Connecticut Avenue, N.W.				
WASHINGTON, DC 20036			1723	

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

~~\* \* Supplemental \* \*~~  
**Office Action Summary**

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/763,282	HEEG ET AL.	
	Examiner Tony G. Soohoo	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “a shaking platform disposed horizontally adjacent;” is so imprecise of the relative positions of the elements being referred in the phrase “adjacent”, it is unclear what is the shaking platform is adjacent to. Is the shaking platform adjacent to a specimen storage position? Is the shaking platform disposed adjacent the base unit? Is the shaking platform disposed adjacent one another? The phrase is read as best understood that the shaking platform is disposed horizontally and is also adjacent to any structure claimed or unclaimed.

The phrase describing that the specimen storage device has specimen storage spaces “wherein the superposed specimen storage spaces are configured to be individually and independently controlled”. The phrase is so imprecise that the phrase is physically impossible in operation. In a real physical sense a “storage space” can not

be individually and independently controllable, since spaces are, in essence, a void between physical walls or boundaries. The walls and boundary of elements defining the space may be controlled, but the space, i.e. a void, can not. Thus, the phrase is meaningless to the claim, and does not point out any positive structure which is controlled or controllable. The phrase is read as best understood that the spaces have the ability such that one may put something into or out from the storage space. There phrase does positively define a transport mechanism to move things into or out of the space.

4. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to point out that the shaking platform is disposed "adjacent" as recited in claim 1.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malterer et al US 2003/0215357 in view of Friedman 6659637.

The Malterer (et al) reference discloses a storage device 10 with plural superimposed storage space positions 200A, 200B, shelves, which teaches each may contain a respective shaking unit module thereby providing plural shakers,

*[0087] Instrumentation shelf modules (200A) and (200B) are designed to support, control, and transfer objects to and from benchtop laboratory instruments mounted as onboard mechanisms of the shelf module. Such laboratory instruments could include, but are not limited to, plate sealers, barcode labeler/applicators, plate seal piercers, liquid handling pipetters, liquid dispensers, plate washers, plate readers, shakers, centrifuges, heaters, dryers, bead stirrers, bead washers, illumination devices, barcode readers, plate carousels, or other similar instruments. The onboard instrument (209) in FIG. 10A is depicted as a traditional laboratory plate reader. That of FIG. 10B is depicted as four traditional thermal cyclers. As the thermal cyclers in FIG. 10B are significantly smaller than the laboratory plate reader of FIG. 10A, multiple of these instruments have been included in instrumentation shelf module (200B). Emphasis added in italics*

see paragraph [0087], line 8, which is held and supported with base clamps 210, and base shelf plate 201 for each respective shaker unit module [0080]. It is also noted that the environment of the storage device may be controlled by a element 130, paragraph [0053].

Malterer et al discloses all of the recited subject matter as defined within the scope of the claims with the exception of particulars of the shaking unit module having a shaking platform with the respective base unit such as a clamp above the spacer to clamp a specimen storage unit of the shaker upon the shaker, or horizontal adjacent configuration of the shaking platform being adjacent.

The Friedman reference teaches a shaker/incubator device may have a base unit 10, connected to motor 21, inherent respective wiring and controllers, and at least one

shaking platform 30, 70, disposed horizontal and disposed adjacent to various elements of the device, a specimen storage unit device for holding plural specimen tubes 50 and the spacer 62, 64 and clamp 61, 63 for clamping the holder for the specimen tubes 50 in the storage holder unit device.

In view of the teaching of Friedman that a shaking unit may include having a base unit connected to motor 21, and a horizontal and adjacent shaking platform 11, 12, it is deemed that it would have been obvious to one of ordinary skill in the art to provide the shaker units Friedman into each of the storage space position shelves of Malterer (et al) so that plural shakers may be operated inside the storage device of the Malterer (et al) reference.

With regards to the permanence (claims 2) or detachable feature (claim 3), note that the device, when operated, is permanent when connected together for operational use, and may be detachable when the device is taken apart for repairs.

With regards to claim 4, the claim is directed to the subcombination of the storage/shaking device and not to the particulars to the automated transport. Evidence is the phrase "is designed for a specimen to be supplied by means of an automated transport system" but does not positively claim the element of an automated transport system. The structure is fully satisfies the capability to be supplied and removed by an appropriate automated robot specifically designed for the removal and supply of the specimen chamber.

With regards to claims 7-11, and 13, and 18-20, note that the device has a control unit would inherently have commonly known use of wires which may be

operatively connected via commonly known wire connectors and distribution system to provide a cooperation with the controller for operation of the device(s).

With regards to claim 12, the positioning of the shaking unit is directed to a claimed recitation to a functional operation of the structure and does not provide a positive recitation of structural limitation to the previously claimed element and only require the ability to operate in such a manner. The provision of the controller and shaker unit with platform may be capable of fully operating to a zero position if the controller is programmed to do so.

#### **Examiner remarks**

7. Note that the recitation of an incubator is deemed and considered to be immaterial to the claimed invention whereby such supportive structure to function to incubate has not been positively claimed in the combination of elements defined as the claimed invention.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following disclose examples of laboratory stacked shelving arrangements in a system: Kaut 4419938, Macindoe, Jr. 5332549, Glass 6247770.

10. Applicant has amended the claims to point out a shaking platform which is horizontally adjacent, and presented new claims 14-20 not presented previously for examination upon merits.

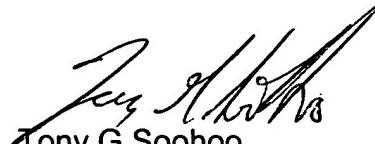
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony G. Soohoo whose telephone number is (571) 272 1147. The examiner can normally be reached on 7-5PM,Tue-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tony G Soohoo  
Primary Examiner  
Art Unit 1723